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# Supreme Court of the United States

OCTOBER TERM, 1925

NUMBER 107

THE ALEXANDER MILBURN COMPANY,

*Petitioner,*

*vs.*

DAVIS-BOURNONVILLE COMPANY,

*Respondent.*

## SUPPLEMENTAL BRIEF FOR PETITIONER

JAMES A. WATSON,
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## SUPPLEMENTAL BRIEF FOR PETITIONER

We desire to bring to the attention of the Court two cases reported in 7 F. R. (2d), the advanced sheets of which came to hand after filing our main brief, as follows:

In Ladd vs. W. & H. Walker, 7 F. (2d) 72 (C. C. A. Third Circuit, decided August 12, 1925), a Bell patent having an earlier filing date than the Ritts patent in suit was set up in defence. The Bell patent was granted later, and the Court said:

> "The Bell patent was not in the prior art, but, while this is true, and while the Bell patent cannot be used as an anticipation, it is pertinent evidence on the questions of priority of invention and infringement" (p. 78).

In Universal Rim Co. vs. Firestone Tire & Rubber Co., 7 F. (2d) 24, (C. C. A. Sixth Circuit, decided July 18, 1925), a patent to Baker was sued on and a patent to Shaw of earlier filing date was set up in defence. The Court said:

> "In accordance with our established view, it must be held that Baker cannot be the first inventor of anything which had previously been completely invented and constructively reduced to practice by Shaw, even though Shaw's patent did not get issued until after Baker's application was filed" (p. 26).

**Constructive Reduction to Practice by Filing a Complete Application Implies Completion of the Invention at the Time of Filing.**

This is substantially stated in the Universal Rim Co. case above, and by this Court in Chapman vs. Wintroath, 252 U. S. 126. In the latter case no claim was made for the invention in controversy until long after the application was filed, yet this Court said:

> "where an invention clearly disclosed in an application, as in this case, is not claimed therein, but is substantially claimed in another application, the original will be deemed a constructive reduction of the invention to practice and the later one will be given the filing date of the earlier, with all its priority of right" (p. 137).

In Smith & Griggs Mfg. Co. vs. Sprague, 123 U. S. 249, two patents to Sprague were sued on. The two patents disclosed the same machine, each claiming different features of it. The applications were filed Dec. 2, 1878, and Nov. 11, 1879. While the claims of the patent on the later application were not made in the earlier application, this Court said:

> "The machines described in the two patents, it is admitted, are substantially the same in construction and operation, both patents being for different parts and combinations of a single machine. For the purposes of this case, therefore, the date of the application is to be taken as of Dec. 2, 1878, being the earlier of the two" (p. 250).

It clearly appears that the filing of an application is evidence of constructive reduction to practice and completion of the invention described therein, whether or not the invention is claimed at the time of filing, and that the doctrine of the Court below that

> "no invention can be intelligently perfected unless it is thought out and concluded, and the only evidence of such perfected invention ordinarily derivable from any patent is a union of disclosure and claim" (R. p. 108).

is not sound.

It has always been held, without restriction as to when claims were made, that the date of the invention to be ascribed to a patent sued on is at least as early as the date of the application, if the application is proved. Bates vs. Coe, 98 U. S. 31, 33. The Barbed Wire Patent, 143 U. S. 275, 280; Worley vs. Tobacco Co., 104 U. S. 340, 342.

A different rule as to a patent set up in defence, accompanied by the application therefor, would be illogical.

Respectfully submitted,

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